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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,798

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Yoshitsugu Morita

71,051-031

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27305

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EXAMINER

LOEWE, ROBERT S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

01/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,798

**Applicant(s)**

MORITA ET AL.

**Examiner**

ROBERT LOEWE

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 6 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 1/12/07
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, instant claim 11 provides for the use of the cured of instant claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 7-10, 12-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita et al. (WO 03/072656).

Claims 1, 2, 4, 8, 13, 14 and 17: Morita et al. teaches a silicone resin composition comprising (A) a silicone resin having a softening temperature exceeding 25 degrees C which satisfies all of the structural limitations of instant claims 1, 4 and 8 (paragraphs 0007-0013), (B) a silicone resin which is a liquid at room temperature (paragraph 0007), and optionally, curing catalysts and fillers (paragraphs 0041 and 0044). Morita et al. further teaches that the structure and substituents present on the silicone resin which is a liquid at room temperature may be the same as component (A) (paragraphs 0025 and 0056). Morita et al. further teaches the addition of a curable resin, which may be, *inter alia*, phenolic resins (paragraph 0031). Among the possible structures for the phenolic resins include those which contain chemically bound polyalkylsiloxane (paragraph 0031). A person having ordinary skill in the art realizes that the phenolic resin additives must have at least two phenolic groups so that it may adequately crosslink with the epoxysilicone resin. Therefore, the teaching provided in paragraph 0031 of Morita et al. is sufficient to render obvious the limitations of component (B) of instant claim 1.

Claims 3 and 12: Since instant claim 1 does not require that the silicone resin be a liquid, component (A) of Morita et al. satisfies all of the limitations of component (A) of instant claim 1. Instant claim 2 requires that the silicone resin be a liquid. Therefore, component (A) of Morita et al. cannot be used to satisfy this limitation. However, the **liquid** silicone resin [component (B) of Morita et al.] would satisfy this limitation provided that the other structural limitations are satisfied. Indeed, Morita et al. suggests that the substituents and structure of the liquid silicone resin may be the same as the solid silicone resin [paragraphs 0021 and 0039]. Therefore for those instances where component (B) of Morita et al. utilizes the same structural features of component (A) of Morita et al., the limitations of instant claim 2 are also satisfied.

Claims 7 and 16: In the examples, Morita et al. teaches that the amount of curing catalyst satisfies the range of instant claims 7 and 16. Morita et al. further teaches that the amount of organic resin (which is taught to include component (B) of instant claim 1) and silicone resins may be present in the amounts of instant claims 7 and 16.

Claims 9 and 18: Morita et al. explicitly teaches that the curable resin composition has superior **flowability** prior to curing (paragraph 0047), it inherently follows that such curable resin compositions are fluid/liquid.

Claim 10: Morita et al. renders obvious cured products obtained by curing the silicone composition of instant claim 1 (paragraph 0047 and examples).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morita et al. (WO 03/072656) in view of Kuwabara et al. (US 2003/0010962).

Morita et al. renders obvious the curable silicone composition of instant claim 1, as described above. Morita et al. does not explicitly teach that the phenolic polyalkylsiloxanes satisfy the formula of instant claim 5. However, Kuwabara et al. teaches polysiloxanes which satisfy the limitations of instant claim 5 (paragraphs 0020-0040). Morita et al. and Kuwabara et al. are combinable because they are from the same field of endeavor, namely, epoxy resin adhesives. Morita et al. and Kuwabara et al. are further combinable because they are concerned with the same technical difficulty, namely, reducing the stress in cured products. At the time of the invention, a person having ordinary skill in the art would have found it obvious to add the phenolic polysiloxane additives as taught by Kuwabara et al. into the compositions as taught by Morita et al. because Morita et al. suggests adding phenolic polysiloxanes to reduce stress in cured products (paragraph 0045 of Morita et al.) and Kuwabara et al. teaches that phenolic polysiloxanes are added to epoxy resin compositions to reduce stress (paragraph 0020).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 and 5 of copending Application No. 11/912,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because when "d" is equal to zero in claim 1 of copending application '631, component (A) of instant claim 1 is substantially similar as component (A) of claim 1 of the '631 application. Component (B) of instant claim 1 is the same as component (B) of claim 4 of the '631 application. Component (C) of instant claim 1 is the same as component (C) of claim 1 of the '631 application. Instant claim 5 is substantially similar to claim 5 of the '631 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Relevant Art Cited***

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

#### ***Allowable Subject Matter***

Claims 6 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, the limitations of instant claims 6 and 15 refer to a

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specific phenolic resin curative which is not taught or suggested by either Morita et al. or Kuwabara et al.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./

Examiner, Art Unit 1796

30-Dec-08



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/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796